



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,949	11/27/2000	Frank M. Richmond	68050	5029

22242 7590 05/05/2003

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

GLESSNER, BRIAN E

ART UNIT PAPER NUMBER

3635

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/722,949

Applicant(s)

RICHMOND, FRANK M.

Examiner

Brian E. Glessner

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-70 is/are pending in the application.
- 4a) Of the above claim(s) 39,43-47,57 and 61-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-38,40-42,48-56,58-60 and 66-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The following office action is in response to the amendment filed on August 19, 2002.

Election/Restrictions

Claims 39, 43-47, 57, and 61-65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of invention. The applicant elected to prosecute the invention of figures 5 and 25 in his previous response. Therefore, since newly filed claims 39, 43-47, 57, and 61-65 do not read on figures 5 and 25, they are withdrawn from consideration.

Claim Rejections - 35 USC § 112

Claims 37, 41, 42, 53-56, 58-60 and 66-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 37, line 3, the phrase "a plane" should be "the plane" because the plane of the resting surface was introduced in claim 35.

Claim 41 recites the limitation "the second resting surface" in line 2. There is insufficient antecedent basis for this limitation in the claim. It appears that claim 41 should be dependent upon claim 40 because claim 40 introduces "a second resting surface". Appropriate correction is required.

In regard to claim 53, lines 12 and 13, the phrases "a resting surface" and "at least one target surface" should be "the resting surface" and "the target surface" because said surfaces were previously introduced in the claim. Appropriate correction is required.

Art Unit: 3635

In regard to claim 55, line 3, the phrase “a plane” should be “the plane” because the plane of the resting surface was previously introduced. Appropriate correction is required.

Claim 59 recites the limitation "the second resting surface" in line 2. There is insufficient antecedent basis for this limitation in the claim. It appears that claim 59 should be dependent upon claim 58 because claim 58 introduces “a second resting surface”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. Claims 35-37, 40, 41, 48, 51, 53-55, 58, 59, 66, and 69 are rejected under 35 U.S.C. 102(e) as being anticipated by Murphy (6,131,361).

In regard to claims 35-37, 40, and 41, Murphy discloses an apparatus for installing building materials (figures 14 and 15S of the Examiner's attachment A) comprising a first surface attached to a resting surface, wherein the resting surface is not in the same plane as the first surface, at least one target surface extending away from a plane of the resting surface, a fastener opening (127, 132, 136A, 136B or any of the other openings in the device) spaced apart from the resting surface, and at least one guide surface continuous with the resting surface and extending away from a plane of the resting surface. The apparatus further comprises a second resting surface and a guide surface continuous with the second resting surface and extending away from a plane of the second resting surface.

In regard to claim 48, Murphy discloses the claimed invention, wherein the device further comprises a positioning feature. The positioning feature is the slot formed integral with the holes. The slots aid in the positioning of the device. Therefore, they are a positioning feature.

In regard to claim 51, Murphy discloses the claimed invention, wherein the apparatus for installing building material is made from a material selected from the group consisting of wood, metal, plastic, and combinations thereof. Murphy discloses that the material could either be metal or plastic, column 1, lines 41-45.

In regard to claims 53 and 54, Murphy discloses a method for installing building material comprising positioning at least one apparatus 110C, 110D for installing building material, attaching the apparatus to an existing structure (figure 16), positioning the building material on a target surface and moving the building material to a resting surface, positioning the building material to a desired location, and securing the material to the structure. The examiner would like to point out that the material is slid over the sloped target surface and onto the resting surface. Further, the device comprises the structural features disclosed in the method claim. These features can be seen in the above rejections of claims 35 and 36.

In regard to claim 55, Murphy discloses the claimed invention, wherein the apparatus further comprises at least one guide surface continuous with the resting surface and extending away from the plane of the resting surface, wherein the building material is contacted with the target surface in a vertical or near vertical position, moved to the guide surface, and moved to the resting surface (figure 4).

In regard to claims 58 and 59, Murphy discloses the claimed method. Claims 58 and 59 are rejected on the same grounds of rejection set forth above with respect to claims 40 and 41.

In regard to claim 66, Murphy discloses the claimed method. Claim 66 is rejected on the same grounds of rejection set forth above with respect to claim 48.

In regard to claim 69, Murphy discloses the claimed method. Claim 69 is rejected on the same grounds of rejection set forth above with respect to claim 51.

2. Claims 35-38, 40-42, 48 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Ewing (2,717,562).

In regard to claims 35-38, 40-42, 48 and 51, Ewing discloses an apparatus (Examiner's attachment B) comprising a first surface attached to a resting surface, wherein the resting surface is not in the same plane as the first surface, at least one target surface extending away from a plane of the resting surface, a fastener 30 in the first surface in combination with a fastening component B, at least one guide surface continuous with the resting surface and extending away from the plane of the resting surface, a second resting surface and at least one guide surface continuous with the second resting surface and extending away from a plane of the second resting surface. The apparatus further comprises a second target surface continuous with the guide surface and extending away from a plane of the second resting surface, and a positioning feature, i.e. the slot 34 shown in figure 2. The apparatus is also made of metal.

3. Claims 35-38, 40-42, 48-51, 53-56, 58-60 and 66-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly, Jr. (4,425,714).

In regard to claims 35-38, 40-42 and 48-51, Kelly discloses an apparatus (Examiner's attachment C) comprising a first surface attached to a resting surface, wherein the resting surface is not in the same plane as the first surface, at least one target surface extending away from a plane of the resting surface, a fastener in the first surface in combination with a fastening component, at least one guide surface continuous with the resting surface and extending away from the plane of the resting surface, a second resting surface and at least one guide surface

Art Unit: 3635

continuous with the second resting surface and extending away from a plane of the second resting surface. The apparatus further comprises a second target surface continuous with the guide surface and extending away from a plane of the second resting surface, and a positioning feature, i.e. the channel formed at the top end of figure 6. The apparatus is also made of metal and further comprises at least one “material thickness” spacer block 28 that comprises an adjustable support surface 30.

In regard to claims 53-56, Kelly discloses a method for installing building material comprising positioning at least one apparatus 10 for installing building material, attaching the apparatus to an existing structure (figure 1), positioning the building material on a target surface and moving the building material to a resting surface, positioning the building material to a desired location, and securing the material to the structure. The examiner would like to point out that the material is slid over the 2nd target surface and onto the resting surface and first target surface. Further, the device comprises the structural features disclosed in the method claim. These features can be seen in the above rejections of claims 35 and 36. The apparatus also comprises a guide surface, wherein the material is contacted with the second target surface in a vertical or near vertical orientation, moved to the guide surface, and moved to the resting surface, and a fastener opening in the first surface in combination with a fastener component (see Examiner’s attachment C).

In regard to claims 58-60, Kelly discloses the claimed method, further comprising the structure disclosed in claims 58-60. Said structure can be seen in the above rejections of claims 40-42. Claims 58-60 are rejected on the same grounds of rejection set forth in said claims 40-42.

In regard to claims 66-69, Kelly discloses the claimed method, further comprising the structure disclosed in claims 66-69. Said structure can be seen in the above rejections of claims 48-51. Claims 66-69 are rejected on the same grounds of rejection set forth in said claims 48-51.

Claim Rejections - 35 USC § 103

2. Claims 38 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (6,131,361).

In regard to claims 38 and 56, Murphy discloses the claimed invention and method except for specifically disclosing a fastener component in combination with the fastener opening 127. However, Murphy does disclose the use of fasteners 150. Therefore, it would have been obvious to one having ordinary skill in the art to place the fastener 150 in any of the fastener openings, depending on the orientation of the device, to secure the device or building material to the structure. The device, as shown, can be oriented in many different positions. Therefore, the fastening component 150 may also have to be located in many different locations.

3. Claim 49 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (6,131,361) in view of Burgess (5,366,329).

In regard to claims 49 and 67, Murphy discloses the claimed invention, except for disclosing the use of a “one material thickness” spacer block. Burgess teaches that it is known to use a “one material thickness” spacer block 5b to provide a space for a drywall panel to be inserted. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate said height block or spacer into Murphy’s invention, because the spacer will provide additional clearance between the apparatus and the studs if needed.

Art Unit: 3635

Further, the examiner contends that the use of spacers where needed is capable of being determined by one having ordinary skill in the art.

4. Claims 50, 52, 68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (6,131,361) in view of Guilmette (5,617,698).

In regard to claims 50, 52, 68 and 70, Murphy discloses the claimed invention, except for the use of a tee support or adjustable positioning device. Guilmette discloses the use of a tee shaped adjustable positioning device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate said device into Murphy's invention, because the device will aid the user in placing the panels. The device will help the user to hold the panel until the at least one apparatus for installing building materials is moved into position to hold the panel. Also, the positioning device could be used as a safety device if one or more of the apparatus for installing building materials failed.

Response to Arguments

Applicant's arguments with respect to claims 35-38, 40-42, 48-56, 58-60, and 67-70 are not persuasive.

Applicant has added the limitation of a target surface and argues that the prior art does not teach or suggest such a limitation. The examiner respectfully disagrees. The prior art does show the use of a target surface, as well as the other features of the claims. Therefore, the claims are rejected in light of the references used above. The examiner would also like to point out that while some of the references are not being used in the same manner as applicant's device, they do meet all of the structural limitations of at least some of the claims. Therefore, if the reference discloses all of the structural features of the claim, it is inherently capable of performing the

Art Unit: 3635

same functions as disclosed by applicant. Just because two devices are shown to function differently does not mean that they are patentably distinct. One must claim the devices so that they are structurally different in order to be patentably distinct.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meyer, Frantello, Bankson, and Schlegel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031. The examiner can normally be reached on Monday-Friday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

B.G.
April 30, 2003



**BRIAN E. GLESSNER
PATENT EXAMINER**